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In re Application of OUZMAN
U.S. Application No.: 10/586,558
PCT Application No.: PCT/GB2005/000183
Int. Filing Date: 19 January 2005
Priority Date Claimed: 21 January 2004
Attorney Docket No.: 13425-194US1 BV-1092 US
For: SYNTHESIS OF SPONGOSINE

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. 1.47(b)" filed 05 January 2009.

BACKGROUND

On 19 January 2005, applicant filed international application PCT/GB2005/000183, which claimed priority of an earlier United Kingdom application filed 21 January 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 04 August 2005. The thirty-month period for paying the basic national fee in the United States expired on 21 July 2006.

On 19 July 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 05 June 2008, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 05 January 2009, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing

inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee will be charged to Deposit Account No. 06-1050 as authorized in the petition.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that inventor Jacqueline Ouzman refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Dr. Ouzman for signature (see Exhibit A). Furthermore, the petition sufficiently illustrates Dr. Ouzman's refusal to sign. In particular, Dr. Ouzman's failure to return an executed declaration in response to the electronic mail message dated 13 April 2008 and her insistence on compensation before signing is deemed a constructive refusal to cooperate. Thus, it can be concluded with reasonable certainty that Dr. Ouzman refuses to join in the application.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, the declaration executed by the 1.47(b) application is improper. Specifically, the title "Head of Patent Dept." does not confer apparent authority to sign on behalf of the applicant. See MPEP 324, Section V.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to

the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant. MPEP 409.03(f)

In the present case, applicant has furnished a copy of an employment agreement signed by the inventor. However, an affidavit signed by a person with firsthand knowledge of the making of the present invention by Dr. Ouzman during her term of employment with Cambridge Biotechnology Limited has not been submitted. It is emphasized that such affidavit must be signed by a person who personally observed Dr. Ouzman making the present invention.

With regard to item (6) above, an adequate statement regarding preservation of the rights of the parties and/or prevention of irreparable damage has been provided.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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